



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/189,130 11/10/98 HOUCK

J 47.653.1

021874 HM12/0329  
DIKE BRONSTEIN ROBERTS & CUSHMAN  
130 WATER STREET  
BOSTON MA 02109-4280

EXAMINER

BORIN, M

ART UNIT

PAPER NUMBER

1654

DATE MAILED:

03/29/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/189,130

Applicant(s)

Houck et al.

Examiner

M. Borin

Group Art Unit

1654



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-23 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-23 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1654

### **Part III DETAILED ACTION**

Claims 1-23 are currently pending.

#### **Restriction Requirement**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to pharmaceutical composition, classified in class , subclass.
- II. Claim 9, drawn to inhibition of degranulation of mast cells, classified in class 514, subclass 18.
- III. Claim 10, drawn to method of treating asthma, classified in class 514, subclass 826.
- IV. Claims 11-14, 22, 23 drawn to method of treating inflammation, classified in class 514, subclass 18.
- V. Claim 15, drawn method of inhibition of release of cytokine, classified in class 514, subclass 18.
- VI. Claim 16, drawn to method of inhibition of release of histamines, classified in class 514, subclass 18.
- VII. Claim 17, drawn to method of inhibition of release of leukotriens, classified in class 514, subclass 18.
- VIII. Claim 18, drawn to method for reducing adhesion, classified in class 514, subclass 18.
- IX. Claim 19, drawn to method for reducing the production of IgE antibodies, classified in class 514, subclass 18.

Art Unit: 1654

- X. Claim 20 , drawn to method for reducing IgE cross-linking, classified in class 514, subclass 18.
- XI. Claim 21 , drawn to method for inhibiting increased vascular permeability, classified in class 514, subclass 18.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, methods II and III are alternate methods of using the compound of Group I. Further, each method of use can be practiced with a broad variety of drugs beyond the claimed peptides.

Inventions II-XI are related as independent and/or distinct methods which are not connected in design, operation or effect. These methods are independent if it can be shown that (1) they are not disclosed as capable of use together, (2) they have different modes of operation, (3) they have different functions, or (4) they have different effects. (MPEP 806.04, MPEP 808.01). The methods of Groups II-XI have different functions, different effects and different modes of operation. A reference teaching one method (e.g., inhibition of release of leukotriens) will not teach or suggest

Art Unit: 1654

another method (e.g., reducing IgE cross-linking). Further, each method has separate enablement requirements.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art because of their recognized divergent subject matter, and the necessity for non-coextensive literature searches, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Serial Number: 09/189130

Page 5

Art Unit: 1654

Ms. Cecilia Tsang can be reached on (703) 308-0254. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

March 25, 1999

mlb

Patent Examiner

A handwritten signature in cursive script, likely belonging to the Patent Examiner.